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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 555255-012611

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on March 8, 2010

Signature: Debra Pejeau

Typed or printed name: Debra Pejeau

Application Number	Filed
10/695,137	10/28/2003

First Named Inventor: Larry E. Hawker

Art Unit	Examiner
2614	Disler Paul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 47,919
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Joseph M. Sauer/
Signature

Joseph M. Sauer
Typed or printed name

216-586-7506
Telephone number

March 8, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

Attorney Docket No.: 555255-012611

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Hawker, et al.
Title	:	SYSTEM AND METHOD OF ACOUSTICALLY SAFE AUTOMATIC HANDSFREE VOLUME ADJUSTMENT
Application No.	:	10/695,137
Filed	:	October 28, 2003
Group Art Unit	:	2614
Examiner	:	Paul Disler

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Dear Sirs:

The Examiner has issued a Final Rejection of the pending claims. The Applicant hereby requests review of the Final Rejection prior to filing an appeal brief for the reasons set forth below. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012611.

ARGUMENT

The Final Office Action issued on December 8, 2009 rejects each of the pending claims under 35 U.S.C. § 103(a). The Applicant respectfully submits that these rejections demonstrate clear error and must be withdrawn. Without waiving the right to argue other issues, the Applicant will show that the rejections are clearly erroneous for at least two reasons: elements are missing from the Examiner's prima facie case for rejection, and the Examiner may not assert "common sense" as a substitute for missing evidence; and "common sense" may not be combined with the cited references because the primary reference to Kraft (U.S. 2002/0107009) teaches away from the claims.

I. Elements are missing from the Examiner's prima facie case.

A. "Safe volume profile" was not in evidence; "common sense" is not evidence.

Independent claim 25 recites a "safe volume profile providing a default volume setting... selected to reduce the risk of damage to a user's hearing if the mobile device is operated in close proximity to the user's ear while in the handsfree mode of operation." A similar limitation is included in independent claim 33. The cited references fail to disclose or suggest any such element.

That the element is missing from the prima facie case is not in dispute. The Examiner has sought to remedy the deficiency by making an unsupported assertion of "common sense." In particular, the Examiner proposes that Kraft's disclosures of a headset and a "hands-free" volume setting for a speaker render the claim element obvious because "it would have been obvious that by common sense the volume set by the user could have been a safe volume setting so that the user's ears would be less likely being [sic] damaged." (Final Office Action, pages 3 and 5, emphasis added) As explained in detail in the Amendment filed on November 4, 2009, this type of unsupported assertion of "common sense" is not a substitute for evidence for the purpose of satisfying the Examiner's burden of proof on the issue of obviousness. In re Lee, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) ("Common knowledge" and "common sense" can be used to evaluate evidence in the record, but they are not themselves evidence).

B. Raising the volume "in handsfree mode" was not in evidence.

Claim 41 recites "initially limiting the volume" of a mobile device, "when the device is manually switched to handsfree mode, to a preset initial level" and "enabling the user to raise the volume, while remaining in handsfree mode... to a level higher than the preset initial level." In rejecting this claim, the Examiner mistakenly points to Kraft's Table 1, along with paragraphs 0015, 0020, 0022 and 0035-0037. This is clearly in error because Kraft does not disclose volume control in handsfree mode. (As discussed below, Kraft actually teaches away from initially limiting the volume when switched into a handsfree mode.) Specifically, Table 1 of the Kraft reference identifies five possible sound volume settings (level 1 – level 5). Kraft's Table 2 further specifies that the ***highest*** possible setting (level 5) is preset for the hands-free mode of operation. Therefore, Kraft does not disclose initially limiting the volume, when the mobile device is switched to handsfree mode, then raising the volume while remaining in handsfree mode. Kraft actually discloses the opposite: initiating the volume in hands-free mode at the highest setting when switched to handsfree mode.

II. Kraft teaches away from the claimed combinations of elements.

Even if it may be assumed for the sake of argument that "common sense" is valid evidence, common sense does not support the Examiner's modification of Kraft. The Kraft reference teaches away from the claimed safe volume profile. The Examiner maintained that Kraft teaches a "hands-free" mode of operation that may be used in conjunction with a headset, and that the volume setting in the "hands-free" mode may be set to a desired level (concluding that it would be obvious "by common sense" to set the volume to a safe default level.) However, the Kraft reference explains that in "hands free" mode, which is used while driving, the sound level is preset to the ***highest*** volume level. (*See,* Kraft, paragraphs 0015 and 0022) (Table 2 specifies that the default sound volume setting (mode/function 7) for the hands-free driving mode (row 6) is level "5", which Table 1 shows as the highest volume level in the "sound volume" category.) Moreover, this is the ***only*** teaching in Kraft about the preset volume level for its "hands-free" mode of operation. The Kraft reference therefore actually teaches the opposite of the

claimed safe volume profile and thus teaches away from the claimed method of initially limiting the volume to a lower level. When a reference teaches away from a claimed combination of elements, that combination is more likely to be nonobvious. United States v. Adams, 383 U.S. 39, 51-52 (1966) (cited by KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007); see also MPEP 2145(X)(D)(2).

III. The Panel Should Allow the Application

This is the second pre-appeal brief conference request filed for this application. In the first request, the Applicant demonstrated that the Examiner's reliance on the inherent teachings of the Kraft reference was without legal merit, and prosecution was reopened. Thereafter, the Examiner has issued two new office actions that cite NO new evidence and that attempt to fill the evidentiary gap with a bare assertion of "common sense." Considering the prosecution history, it is apparent that the Examiner is unable to establish a *prime facie* rejection of the claims and that further prosecution is unwarranted. The Panel is therefore respectfully requested to recommend allowance of the application.

Respectfully submitted,

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